

## **REMARKS**

**[0003]** Applicant respectfully requests reconsideration and allowance of all presently pending claims of the application. Claims 1, 3-5, 7-10, 12-16, 18-19, 21-28 are presently pending. Claims amended herein are: 1, 7-8, 12-16, 18-19, 21-25. Claims withdrawn or cancelled herein are: 2, 6, 11, 17, 20, 29.

### **Statement of Substance of Interview**

**[0004]** The Examiner graciously talked with me—the undersigned representative for the Applicant—on Tuesday March 11<sup>th</sup>. Applicant greatly appreciates the Examiner's willingness to talk. Such willingness is invaluable to both of us in our common goal of an expedited prosecution of this patent application.

**[0005]** During the interview, we discussed how the claims differed from the cited art, namely Brugliera. Without conceding the propriety of the rejections and in the interest of expediting prosecution, I also proposed several possible clarifying amendments. We also discussed the Section 112 rejections of claims 12, 21-24. We also discussed the Section 101 rejection of claims 22-24.

**[0006]** I understood the Examiner to agree that the disclosure of the instant application was distinct from the cited references. The Examiner suggested Applicant submit clarifying amendments to the claims in view of the specification.

**[0007]** I understood the Examiner to agree that the original claim language in claims 12, 21-24 fulfilled the requirements of Section 112. The Examiner agreed to remove the Section 112 rejection of claims 12, 21-24.

**[0008]** I understood the Examiner to agree that the proposed amendment to claims 22-24 including the term “tangible” to the preamble of the claims would fulfill the requirements of Section 101. I understood the Examiner to agree to remove the Section 101 rejections of claims 22-24 upon submission of amendments as discussed during the Examiner interview.

**[0009]** Applicant herein amends the claims in the manner discussed during the interview. Accordingly, Applicant submits that the pending claims are allowable over the cited references of record for at least the reasons discussed during the interview.

#### **Formal Request for an Interview**

**[0010]** If the Examiner’s reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can talk about this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

**[0011]** Please contact me to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for me, I welcome your call as well. My contact information may be found on the last page of this response.

#### **Claim Amendments**

**[0012]** Without conceding the propriety of the rejections herein and in the interest of expediting prosecution, Applicant amends claims 1, 7-8, 12-16, 18-19,

21-25 herein. All amendments are fully supported by the current specification. Applicant amends the claims to clarify claimed features in accordance with the discussion with the examiner. Such amendments are made to expedite prosecution and quickly identify allowable subject matter. Such amendments are merely intended to clarify the claimed features, and should not be construed as further limiting the claims in response to cited references.

## **Substantive Matters**

### **Claim Rejections under §112 2<sup>nd</sup> ¶**

[0013] 12, 19 and 21-24 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> ¶. In light of the amendments presented herein which were discussed during the above mentioned Examiner interview, Applicant submits that these rejections are moot. Accordingly, Applicant asks the Examiner to withdraw these rejections.

### **Claim Rejections under §101**

[0014] Claims 22-24 are rejected under 35 U.S.C. §101. In light of the amendments presented herein which were discussed and agreed upon during the above mentioned Examiner interview, Applicant respectfully submits that these claims comply with the patentability requirements of §101 and that the §101 rejections should be withdrawn. The Applicant further asserts that these claims are allowable. Accordingly, Applicant asks the Examiner to withdraw these rejections.

[0015] Without conceding the propriety of the rejections herein and in the interest of expediting prosecution Applicant similarly amends claims 12 and 21.

[0016] If the Examiner maintains the rejection of these claims, then the Applicant requests additional guidance as to what is necessary to overcome the rejection.

**Claim Rejections under §§ 102 and 103**

[0017] Examiner rejects claims 1, 3-7, 9-13, 15 and 17-29 under §102. For the reasons set forth below, the Examiner has not shown that cited references anticipate the rejected claims.

[0018] In addition, the Examiner rejects claims 2, 8, 14, and 16 under §103. For the reasons set forth below, the Examiner has not made a prima facie case showing that the rejected claims are obvious.

[0019] Accordingly, Applicant respectfully requests that the §102 and §103 rejections be withdrawn and the case be passed along to issuance.

[0020] The Examiner's rejections are based upon the following references alone and in combination:

- **Brugliera:** *Brugliera*, "Digital On-Screen Display: A New Technology for the Consumer Interface".;
- **EP 0 952 735:** *EP 0 952 735, et al.*, US Patent Publication No. 2007/5938503 (Published August 31, 2007); and

- **WO 99/60790:** *WO 99/60790; Focus on OpenView: A guide to Hewlett-Packard's Network and Systems Management Platform.* Fort Washington, PA, USA: CBM Books (1995).
- 

### **Overview of the Application**

**[0021]** The Application describes a technology for a client device receiving a request to display a program guide. After identifying program schedule information that has been acquired from a program schedule information provider, the client device generates a custom scrolling program guide or a custom interactive program guide per the user's request and communicates the program guide to a display device. The program guide may contain the program schedule information as well as additional information targeted to a user of the client device based upon information gathered by the client device regarding the user.

## **Cited References**

**[0022]** The Examiner cites Brugliera as the primary reference in the anticipation- and/or obviousness-based rejections. The Examiner cites EP 0 952 735 and WO 99/60790 as secondary references in the obviousness-based rejections.

### **Brugliera**

**[0023]** Brugliera describes a technology for cable system operators to generate and deliver on screen displays to cable system subscribers.

### **EP 0 952 735**

**[0024]** EP 0 952 735 describes a technology for a system interactively controlled by a TV viewer remote control transmitter displaying portions of a scroll program guide on the viewer's display screen..

### **WO 99/60790**

**[0025]** WO 99/60790 is a book on the topic of an interactive television program guide system is provided in which a viewer may direct a television to simultaneously display a selected television program and a program guide display.

## **Anticipation Rejections**

**[0026]** Applicant submits that the anticipation rejections are not valid because, for each rejected claim, no single reference discloses each and every element of that rejected claim.<sup>1</sup> Furthermore, the elements disclosed in the single reference are not arranged in the manner recited by each rejected claim.<sup>2</sup>

### **Based upon Brugliera**

**[0027]** The Examiner rejects claims 1, 3-7, 9-13, 15, and 17-29 under 35 U.S.C. § 102(b) as being anticipated by Brugliera. Applicant respectfully traverses the rejections of these claims. Based on the reasons given below, Applicant asks the Examiner to withdraw the rejection of these claims.

### **35 U.S.C. § 102(b) Rejection of Independent Claim 1**

**[0028]** The Office rejects claim 1 as being unpatentable over Brugliera on pages 3-4 of the current Action

**[0029]** Evidence relied on by the Office

Brugliera: p. 578, 582, 583; 584 Fig. 7

---

<sup>1</sup> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); also see MPEP §2131.

<sup>2</sup> See *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

**[0030]** Findings of Fact

- a. The Brugliera reference discloses an "interactive on-screen-display system that puts subscribers a touch-of-a-button away from electronic program guides, special converter features, messages, pay-per-view, and other data services." (p.578)
- b. The Brugliera reference discloses two user entities: the Subscriber and the System Operator (p. 582-3)
- c. The Brugliera reference discloses the "system operator has the option of choosing either grid format . . . , or a 'scrolling' type of format, . . ." (p. 582-3)
- d. The Brugliera reference discloses customization of a View Guide Menu "the menus can be customized to suit a particular market. Most screens and features can be added or deleted upon the specific needs and capabilities of each cable system.
- e. The Brugliera reference discloses that "Viewer Guides" is a Menu within the "Interactive On-Screen-Display" and a "Program Guide" is a selection from within this menu. (p. 583, Fig 5.)



- f. The Brugliera reference discloses that the Program Guide “displays interactive programming information supplied by agreement with the program data companies”. The features of which “vary depending upon the programming service chosen”. (p.582)

[0031] Applicant submits that Brugliera does not anticipate this claim because it does not show or disclose the following elements as recited in this claim (with emphasis added):

A method implemented by a set top box comprising:

**generating** a custom program guide, . . .

communicating the-generated custom program guide to the connected display device, the custom **program guide being available only on the display device connected to the set top box. . .**

[0032] In this Action, the office equates an “interactive on-screen display system” with a program guide that is generated in view of user interaction. Brugliera discloses an interactive system of menus which allow a user to navigate to a Viewer Guide menu within which is a menu item that, when selected, displays a Program Guide that is pre-designed by the System Operator for display on all display devices within a given market. Brugliera does not disclose a “custom program guide” with “program information being selected in view of

preferences collected from a user of the set top box.” Which is in turn “available only on the display device connected to the set top box.”

**[0033]** In this Action, the office equates the generation of a program guide by a set top box with the generation of a program guide by server controlled by a System Operator. These two components are not the same and do not serve the same purpose. The server component of the system run by the System Operator is delivers a Program Guide to all display devices in the services market. (FF d ) The design of the Program Guide is dictated by the System Operator and is consistent across all display devices in the market. (FF d,e ) This, System Operator provided program guide is not a “custom program guide being available only on the display device connected to the set top box” as is currently claimed.

**[0034]** Consequently, Brugliera does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

*35 U.S.C. § 102(b) Rejection of Independent Claim 13*

**[0035]** The Office rejects claim 13 as being unpatentable over Brugliera on pages 3-4 of the current Action for at least the same reasons as Claim 1 and the following evidence.:

**[0036]** Evidence relied on by the Office

Brugliera: p. 584 Fig. 7

**[0037]** Findings of Fact

- g. The Brugliera reference discloses user input. (Fig 7)
- h. The Brugliera reference discloses user input causing the display of program information. (p. 584)

**[0038]** In this Action the Office equates pressing an “INFO” button to display additional information about a single program with the claimed:

“detecting a user input, wherein the user input is a request to change the format of the program guide; and changing operation of the custom program guide to display program schedule information in an interactive format.”

**[0039]** A request to change program guide format is not equivalent to pressing an “info” button. Changing the design and function of the program guide from scrolling to interactive is not equivalent to displaying information about a program.

**[0040]** In addition Brugliera discloses changing the format of the program guide by the system operator (FF c ). The choice of format by the system operator impacts the entire market of connected display devices (FF d ). The choice of format as claimed is done by the viewer and impacts only the display device connected to the viewer’s set-top-box.

**[0041]** Consequently, Brugliera does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

35 U.S.C. § 102(b) Rejection of Independent Claim 22

**[0042]** The Office rejects claim 22 as being unpatentable over Brugliera on page 6 of the current Action.

**[0043]** Evidence relied on by the Office

Brugliera: p. 581-583

**[0044]** Findings of Fact

- i. The Brugliera reference discloses display of program schedule information, advertisements, promotions, and information. (581-583)
- j. The Brugliera reference discloses “channels can have a designated barker message . . . Different groups of decoders can also have different barker messages generated.” “The overall [barker] system is managed by the system controller and associated software.” (p.576)
- k. The Brugliera reference discloses a System Controller that is a computing system operated by a System Operator. (Fig. 1., p. 572-3)

**[0045]** In this Action the Office claims that the methods claimed in Claim 22 are inherently present in the disclosure of Brugliera. Brugliera and the instant application both disclose methods that when implemented display similar content types. The Examiner makes the conclusion that since the content types are similar, the methods for their display are inherently similar. This is not the case. The Brugliera reference explicitly discloses designating barker messages to specific channels and / or groups of decoders. (FF j ) The immediate application claims

*“selected promotional content wherein the selected promotional content is selected from a plurality of promotional contents, the selection based upon the information regarding the viewer.”*

Brugliera explicitly discloses using channels and decoder ID to direct defined content; Brugliera does not require making a selection of content based upon "information regarding the viewer".

**[0046]** Furthermore, the instant application claims that information regarding the user is defined as:

*"one of a plurality of information types, the plurality of information types comprising: viewer preferences, previously viewed programs, viewing history, system parameters."*

Brugliera does not disclose or inherently require these viewer information data types in order to deliver the disclosed content yet the system described by Brugliera successfully delivers the content. Therefore, the claimed medium and program are not inherently required to display the program schedule information, advertisements, promotions, and information.

**[0047]** Consequently, Brugliera does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

35 U.S.C. § 102(b) Rejection of Independent Claim 25

[0048] The Office rejects claim 25 as being unpatentable over Brugliera on page 7 of the current Action.

[0049] Evidence relied on by the Office

Brugliera: p. 582-3

[0050] Findings of Fact

I. The Brugliera reference discloses “two weeks of programming information can be downloaded to the decoders at a time. The system operator has the option of choosing either grid format... or a ‘scrolling type of format’” (582-3)

[0051] In the current Action on page 7 the Office astutely proves that the Brugliera reference discloses processors and memories capable of storing a program **guide** that has been designed and delivered by a **system operator**. The Office does not show Brugliera discloses a set-top-box apparatus able to store program schedule **information** from a **program schedule information provider** and then **generate** a **custom** scrolling program guide that is displayed exclusively upon a display device connected to the set-top-box.

[0052] Consequently, Brugliera does not disclose all of the claimed elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

### Dependent Claims 2-12

**[0053]** These claims ultimately depend upon independent claim 1. As discussed above, claim 1 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

**[0054]** Claim 4 recites “generating a program guide in response to tuning the client device to a channel associated with the program guide.” First Brugliera does not disclose the “generation” of a program guide. Second, Brugliera discloses broadcasting a program guide on a specific channel, or receiving a request to display a program guide via an OSD Menu selection, or the use of a “Menu” button. Brugliera does not disclose generating a program guide “in response to” tuning to a specific channel. “Generating in response to...” implies that prior to the tuning to the channel in question, no guide previously existed and one is “Generated” at the time of tuning to the channel. The “Barker” channels disclosed by Brugliera, the TV Guide Channel, and the Prevue Channel as cited by the the examiner are in themselves content; broadcast on the said channel. The content is created by the system operator and exists continuously on the frequency of the channel regardless of the current channel



selection of the viewer. When the viewer tunes to the “Barker” channel, the set-top-box displays the current state of the broadcast; No “**generation**” of a program guide takes place.

**[0055]** Claim 5 recites “*a program guide is generated in response to tuning the client device to a virtual channel.*” This claim is allowable for at least the same reasons given for claim 4. In addition, Brugliera does not disclose or imply a virtual channel or the use of a virtual channel to cause the generation of a program guide.

**[0056]** Claim 10 recites a configuration file. Brugliera does not disclose a configuration file, nor is a configuration file inherent. It is possible for the system disclosed by Brugliera to be implemented by means other than those described in claim 10. As an example, the configuration of set top devices may be done at time of manufacture configuration being stored upon non-volatile memories. Configuration could also be done by manual manipulation of circuit-jumpers or switches.

#### Dependent Claims 14-21

**[0057]** These claims ultimately depend upon independent claim 13. As discussed above, claim 13 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

**[0058]** Claim 18 recites two parts to a program guide. Brugliera does not disclose a program guide with two portions. Furthermore, Brugliera does not disclose a portion of a two portion program guide wherein the content is generated by a set-top-box.

**[0059]** Claim 19 recites selecting portions of additional information received by a broadcast signal. This claim is allowable for at least the reasons given for claims 13 and 18. Furthermore Brugliera does not disclose “ *selecting portions of the custom program schedule and the additional information by the set-top-box is based upon set-top-box user data collected by the set-top-box,....*”

**Dependent Claims 23-24**

**[0060]** These claims ultimately depend upon independent claim 22. As discussed above, claim 22 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

**[0061]** Claim 24 recites “*change an operating mode of the custom program guide from a scrolling mode to an interactive mode in response to viewer input.*” Brugliera does not disclose changing the mode of the Program guide by the viewer. Brugliera separately discloses user inputs, a scrolling mode, a choice between scrolling and grid mode by the system operator and an interactive menu system used by the viewer. But, Brugliera does not disclose the claim elements as recited.

Dependent Claims 26-29

[0062] These claims ultimately depend upon independent claim 25. As discussed above, claim 25 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

[0063] Claim 27 is allowable for at least the reasons given for claim 25. Furthermore, claim 27 recites "*additional information received via broadcast channel*" Brugliera discloses additional information but does not disclose "*received via broadcast channel*".

## **Dependent Claims**

[0064] In addition to its own merits, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.

## **Conclusion**

[0065] All pending claims are in condition for allowance. Applicant respectfully requests reconsideration and prompt issuance of the application. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact me before issuing a subsequent Action.** Please call/email me or my assistant at your convenience.

Dated: 03/31/2008

Respectfully Submitted,

By: 

Clay D. Hagler  
Reg. No. 61,804  
(509) 324-9256 x223  
clay@leehayes.com  
[www.leehayes.com](http://www.leehayes.com)

My Assistant: Carly Bokarica  
(509) 324-9256 x264  
[carly@leehayes.com](mailto:carly@leehayes.com)